

a server, said server including a program accessible over the Internet by a user of the computer for controlling the Internet browser interface; and

a file downloadable by said server to the computer for controlling the Internet browser interface in the form of an added user toolbar offering user toolbar functionality that remains available to a user of the computer regardless of the Internet site to which the Internet browser is caused to navigate.

REMARKS

This Amendment is being filed in response to an Office Action mailed on May 23, 2002. Applicant respectfully requests entry of the instant Amendment and reconsideration of the present application in light of the amendments and remarks set forth herein.

Claims 53-68 and 77-86 are currently pending in the present application. By this Amendment, the applicant has amended claims 53 and 77, and respectfully submits that no new matter is added by the amendments set forth herein.

The Examiner has rejected claims 53, 56, 77-79, 82 and 84 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,848,424 to Scheinkman et al. Applicant respectfully traverses that rejection. Scheinkman et al. discloses modifying the behavior of an Internet browser by a plug-in to provide a Mediator-enabled browser display. The Mediator-enabled browser display includes a toolbar 50 that changes "depending on what server the browser is currently connected to." See, e.g., column 4, lines 11-13. The Scheinkman toolbar changes and is controlled by special "Mediator-enabled" websites as the user navigates the Web. Thus, Scheinkman's browser has no enhanced features or functionality, and acts as an ordinary non-enhanced

browser, when encountering an ordinary Web site. The Scheinkman browser only acts as a "Mediator-enabled" browser when encountering a special type of server called "Mediator-enabled" server. When a user causes the Scheinkman browser to navigate to a Mediator-enabled server or Web site, the home page from that Web site includes embedded code that instructs the browser to load a Mediator plug-in that provides additional functionality to the browser display. See, e.g., column 4, lines 28-48. Otherwise, the browser operates as an ordinary browser and has no added functionality.

Applicant's invention, in contrast, and as recited by claim 53, for example, is directed to a method of controlling an Internet browser interface comprising, *inter alia*, the step of making available for downloading by the predetermined Internet site, a file for displaying of a user toolbar that offers functionality that is not dependent upon the Internet site to which the Internet browser is caused to navigate. Applicant's invention adds a user toolbar that is not affected by, and is independent of the various Web sites to which the user causes the browser to navigate as the user surfs the Web. Applicant respectfully submits that the "Mediator-enabled" browser of Scheinkman et al., which only functions at certain specially modified web sites, bears a significant disadvantage, and indeed teaches away from the present invention

Applicant's invention, as recited by independent claim 77, and as recited by dependent claims 56, 78, 79, 82 and 84, which depend from one of claims 53 and 77, are similarly distinguishable from Scheinkman et al.

Applicant thus respectfully submit that the present invention, as recited by claims 53, 56, 77-79, 82 and 84, is patentably distinguishable over Scheinkman et al. Applicant further respectfully submits that the invention recited by claims 53, 56, 77-79, 82 and 84 is not anticipated

by Scheinkman et al., as that reference fails to teach or suggest each element recited by those claims, as is required of a proper 35 U.S.C. § 102(e) reference. See, e.g., MPEP § 706.02. Finally, applicant respectfully submits that the Examiner's rejection of claims 53, 56, 77-79, 82 and 84 as anticipated by Scheinkman et al. is no longer tenable, and respectfully requests withdrawal of that rejection. Applicant further respectfully submits that the invention recited by claims 53, 56, 77-79, 82 and 84 is not rendered obvious by any proposed hypothetical combination of Scheinkman et al. and any other prior art of record or with the knowledge of a person of ordinary skill in the art.

The Examiner has also rejected claims 61-63 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 5,914,714 to Brown. Applicant respectfully traverses that rejection. Brown teaches altering one or more characteristics of an existing toolbar button on an existing browser toolbar by direct manipulation of the toolbar button. See, e.g., column 2, lines 34-43. There is no teaching or suggestion in Brown of an Internet browser interface having an added user toolbar as recited by applicant's claim 61. Brown simply teaches that the buttons on a standard browser toolbar may be changed. Nowhere does Brown disclose an added user toolbar, as claimed and described. Thus, applicant respectfully submits that Brown neither teaches nor suggests the present invention as recited by claim 61-63.

Applicant thus respectfully submits that the instant invention, as recited by claims 61-63, is patentably distinguishable over Brown. Applicant further respectfully submits that the invention recited by claims 61-63 is not anticipated by Brown, as that reference fails to teach or suggest each element recited by those claims, as is required of a proper 35 U.S.C. § 102(e) reference. See, e.g., MPEP § 706.02. Finally, applicant respectfully submit that the Examiner's rejection of claims

61-63 as anticipated by Brown is no longer tenable, and respectfully requests withdrawal of that rejection. Applicant further respectfully submits that the invention recited by claims 61-63 is not rendered obvious by any proposed hypothetical combination of Scheinkman et al. and any other prior art of record or with the knowledge of a person of ordinary skill in the art.

The Examiner has rejected claims 54, 57 and 81 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. in view of Brown. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. Applicant further respectfully submits that the deficiencies noted above with regard to Scheinkman et al. and Brown are not overcome with regard to claims 54, 57 and 81, as those claims depend, directly or indirectly from one of claims 53 and 77. As noted above, applicant respectfully submits that the Mediator-enabled browser display of Scheinkman et al. includes a toolbar 50 that only functions when connected to a special Website. Thus, the toolbar of Scheinkman et al. changes and is necessarily controlled only by special Web sites as the user navigates the Web. Also as noted above with regard to claims 61-63, Brown teaches altering one or more characteristics of an existing toolbar button by direct manipulation of the toolbar button. Thus, the Examiner's proposed combination of Scheinkman et al. and Brown teaches altering one or more characteristics of an existing toolbar button of a Mediator-enabled browser display. As set forth above in detail, applicant respectfully submits that the present invention is clearly distinguishable over Scheinkman et al. and Brown, whether considered alone or in the Examiner's proposed combination. Thus, applicant respectfully request withdrawal of the rejection of claims 54, 57 and 81.

The Examiner has rejected claim 58 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. and Brown, and further in view of U.S. Patent No. 6,009,459 to Belfiore et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. In addition to the arguments set forth above with respect to Scheinkman and Brown, which are applicable to claim 58, Belfiore et al. only discloses a method of automatically initiating a search for a resource such as a web site. When a search is initiated, "the web browser may call multiple search engines...or may, alternatively, call different search engines depending upon the nature of the text that is entered" for the search. See, e.g., column 6, lines 41-44. Thus, Belfiore et al. teaches searching at a plurality of web sites possibly using multiple search engines, either simultaneously or separately. Applicant respectfully submits that that is not the present invention, as recited by claim 58, which recites that "the interface object is a search window that enables the user to initiate a search at the predetermined Internet site." That inventive feature is neither taught nor suggested by Belfiore et al. For the reasons just stated, and for the reasons set forth above with regard to Scheinkman et al. and Brown, applicant respectfully submits that the present invention is not rendered obvious by the Examiner's proposed combination of Scheinkman et al., Brown, and Belfiore et al. Applicant respectfully requests withdrawal of the Examiner's rejection of claim 58.

The Examiner has rejected claims 59 and 60 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. and further in view of U.S. Patent No. 6,020,884 to MacNaughton et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner,

and thus the combination is improper. In addition to the arguments set forth above with respect to Scheinkman, MacNaughton et al. only teaches a system and method for integrating an on-line service community with a foreign service such as the Internet. See, e.g., Abstract. MacNaughton et al. further teaches a toolbar 196 comprised of control buttons and a viewer, and that operates as an extension of the user's browser. A "Toolbar and Capabilities Manager 68 is responsible for creating and managing the Community "Toolbar" that appears on the user's screen." See, e.g., column 10, lines 55-58. As noted by the Examiner, MacNaughton et al. only teaches that the "toolbar and Capabilities Manager 68 interacts with the Capability Handler(s) so that the toolbar controls for various capabilities are made available to the user." See, e.g., column 10, lines 63-66. However, that disclosure does not overcome the shortcomings of Scheinkman et al., as set forth in detail above. Moreover, as claims 59 and 60 depend directly and indirectly from claim 53, applicant respectfully submits that the invention recited by those claims is not rendered obvious by the Examiner's proposed combination of Scheinkman et al. and MacNaughton et al. Applicant thus respectfully submits that the invention recited by claims 59 and 60 is patentable over the Examiner's proposed combination of Scheinkman et al. and MacNaughton et al., and respectfully requests that the Examiner withdraw his rejection of those claims.

The Examiner has rejected claims 85 and 86 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. and further in view of U.S. Patent No. 6,119,098 to Guyot et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. In addition to the arguments set forth above with respect

to Sheinkman, Guyot et al. only teaches a system and method for targeting and distributing advertisements over the Internet. A client application displays downloaded advertisements in an advertising window that is continuously displayed on a subscriber's computer, even if other applications are running at the same time. See, e.g. column 2, lines 2-6. Guyot does not teach the establishing of a link to a predetermined website to receive information to define an interface object. Further, the shortcomings of Scheinkman et al., as set forth in detail above, in no way overcome by the disclosure of Guyot et al. Thus, applicant respectfully submits that the invention recited by claims 85 and 86 is not rendered obvious by the Examiner's proposed combination of Scheinkman et al. and Guyot et al., and applicant respectfully requests withdrawal of that rejection.

The Examiner has rejected claim 64 under 35 U.S.C. §103(a) as unpatentable over Brown in view of Belfiore et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. Further, claim 64 depends indirectly from claim 61. Thus, applicant's remarks provided above with regard to Brown and Belfiore et al. vis-à-vis claim 61 apply to claim 64. More specifically, applicant respectfully submits that Brown only teaches altering one or more characteristics of a toolbar button by direct manipulation of the toolbar button. See, e.g., column 2, lines 40-43. Belfiore et al. teaches searching at a plurality of web sites, either simultaneously or separately. The respective shortcomings of those two references are not overcome by the Examiner's proposed combination thereof as applied to claim 64. Applicant thus respectfully submits that claim 64 is not rendered

obvious by that proposed combination and respectfully requests withdrawal of the Examiner's rejection of that claim.

The Examiner has rejected claims 65 and 66 under 35 U.S.C. §103(a) as unpatentable over Brown in view of U.S. Patent No. 6,292,185 to Ko et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. Ko et al. only teaches "a method and apparatus for tailoring a graphical user interface," where the graphical interface may include a web browser. See, e.g., column 1, lines 21-22 and lines 57-58. In accordance with the teachings of Ko et al., an entirely new, customized web browser is provided that "accesses functional programs of the user's minimized web browser." See, e.g., column 7, lines 9-13. Thus, the "original browser" interface must be minimized and replaced by a completely new customized browser interface. Applicant respectfully submits that that is clearly not the invention recited by claims 65 and 66. In addition, as claims 65 and 66 depend indirectly from claim 61, the distinguishing remarks set forth above with regard to that claim and Brown also apply to the Examiner's rejection of claims 65 and 66. Moreover, the shortcomings of Brown set forth above with regard to claim 61 are fully applicable here and are not overcome by the teachings of Ko et al. Applicant thus respectfully submits that claims 65 and 66 are not rendered obvious by the Examiner's proposed combination of Brown and Ko et al., and applicant respectfully requests withdrawal of the rejection of those claims.

The Examiner has rejected claim 67 under 35 U.S.C. §103(a) as unpatentable over Brown in view of MacNaughton et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical

combination proposed by the Examiner, and thus the combination is improper. Further, claim 67 depends indirectly from claim 61, and the distinguishing remarks set forth above with regard to that claim and Brown also apply to the Examiner's rejection of claim 67. Moreover, the shortcomings of Brown set forth above with regard to claim 61 are not overcome by the teachings of MacNaughton et al. Applicant thus respectfully submits that claim 67 is not rendered obvious by the Examiner's proposed combination of Brown and MacNaughton et al., and applicant respectfully requests withdrawal of the rejection of that claim.

The Examiner has rejected claim 68 under 35 U.S.C. §103(a) as unpatentable over Brown and MacNaughton et al., and further in view of Guyot et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. Further, claim 68 depends indirectly from claim 61, and the distinguishing remarks set forth above with regard to that claim and Brown also apply to the Examiner's rejection of claim 68. Moreover, the shortcomings of Brown set forth above with regard to claim 61 are not overcome by the teachings of MacNaughton et al. and/or Guyot et al. Applicant thus respectfully submits that claim 68 is not rendered obvious by the Examiner's proposed combination of Brown, MacNaughton et al. and Guyot et al., and applicant respectfully requests withdrawal of the rejection of that claim.

The Examiner has rejected claims 55 and 80 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. and further in view of Ko et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper.

Further, claims 55 and 80 depend, directly or indirectly from claims 53 and 77, and the distinguishing remarks set forth above with regard to those claims and Scheinkman et al. also apply to the Examiner's rejection of claims 55 and 80. Moreover, the shortcomings of Scheinkman et al. set forth above with regard to claim 53 and 77 are not overcome by the teachings of Ko et al. Applicant thus respectfully submits that claims 55 and 80 are not rendered obvious by the Examiner's proposed combination of Scheinkman et al. and Ko et al., and applicant respectfully requests withdrawal of the rejection of those claims.

The Examiner has rejected claim 83 under 35 U.S.C. §103(a) as unpatentable over Scheinkman et al. and further in view of Belfiore et al. Applicant respectfully traverses that rejection. In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. Further, claim 83 depends indirectly from claim 77, and the distinguishing remarks set forth above with regard to that claim and Scheinkman et al. also apply to the Examiner's rejection of claim 83. Moreover, the shortcomings of Scheinkman et al. set forth above with regard to claim 77 are not overcome by the teachings of Belfiore et al. Applicant thus respectfully submits that claim 83 is not rendered obvious by the Examiner's proposed combination of Scheinkman et al. and Belfiore et al., and applicant respectfully requests withdrawal of the rejection of that claim.

Applicants have considered the prior art of record, and respectfully submit that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

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Applicant respectfully requests reconsideration of the present application in view of the amendments to the claims and in view of the remarks provided herein.

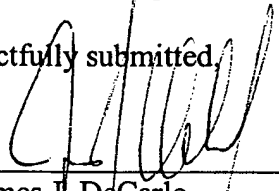
Pages 14 and 15 of this Amendment, titled CHANGES MADE TO THE CLAIMS, indicate the changes made to the claims in accordance with this Amendment.

Early and favorable consideration of the present application in view of the amendments to the claims and remarks provided herein is respectfully requested. If the Examiner is not in a position to allow all claims as presently amended, the Examiner is urged to call the undersigned attorney at 212-806-5400.

Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No. 19-4709.

Respectfully submitted,

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CHANGES MADE TO THE CLAIMS

53. (Amended) A method of controlling an Internet browser interface displayable by an Internet browser on a display of a computer, the Internet browser enabling a user of the computer and Internet browser to access and navigate the Internet and to receive and display on the computer display one or more web pages from one or more Internet sites, including the display of a web page from a predetermined Internet site, the Internet browser having at least one Internet browser toolbar having at least one toolbar button providing a predetermined functionality to the user of the computer and Internet browser, said method comprising the steps of:

- (a) providing, at the predetermined Internet site, access to a program for controlling the Internet browser interface; and
- (b) making available for downloading by the predetermined Internet site, a file for displaying of a user toolbar that makes additional functionality available to the user as part of the Internet browser interface, such that once the user toolbar is displayed the user toolbar remains displayed and said additional functionality remains available to the user regardless of the Internet site to which the Internet browser is caused to navigate.

77. (Amended) A system for controlling an Internet browser interface displayable by an Internet browser on a display of a computer, said system comprising:

 a server, said server including a program accessible over the Internet by a user of the computer for controlling the Internet browser interface; and

Application Serial No.: 09/429,585
August 22, 2002

a file downloadable by said server to the computer for controlling the Internet browser interface in the form of an added user toolbar offering user toolbar functionality that remains available to a user of the computer regardless of the Internet site to which the Internet browser is caused to navigate.